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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,926	12/16/2005	Lone Andersen	GRP-0101	6586

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EXAMINER
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CORBIN, ARTHUR L

ART UNIT	PAPER NUMBER
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1794

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,926	<b>Applicant(s)</b> ANDERSEN ET AL.	
	<b>Examiner</b> Arthur L. Corbin	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08-29-05, 07-26-06, 11-10-06.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-67 is/are rejected.  
 7) ☒ Claim(s) 7, 8 and 16 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 03-23-05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>082905.072606.111006</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 7, 8 and 16 are objected to because of the following informalities: In claims 7 and 8, line 2, "a" should be cancelled, and line 3, "temperature" should be plural. In claim 16, line 2, "transition" should be singular. Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 47, 48 and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis: in claim 1 for "the biodegradable polymer" (claim 47, line 2) and in claim 47 for "lactone monomers" (claim 48, line 2). Claim 67 is an improper dependent claim since it does not further limit the scope of claim 1, from which it depends. Corrections are required without new matter.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-22, 26-29, 32-36, 38, 39, 41, 42, 46-51, 53-56, 61, 63 and 67 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldberg et al (WO 01/47368, pages 4-7, 9-14, 19). Goldberg et al discloses a chewing gum, free of non-biodegradable polymers (claims 26, 27, 46), including two different biodegradable polymers as claimed by applicant (claims 2, 5, 12, 18-21, 47-50) having molecular weights and glass transition temperatures within applicant's claimed ranges (claims 3, 4, 6-11, 13-17). The chewing gum also includes conventional ingredients, i.e. resins, softeners, sweeteners, flavoring agents, fillers, coloring agents and film forming agents as claimed by applicant (claims 28, 29, 32-39, 41, 42, 51, 53, 63). The chewing gum in Goldberg et al may be coated with a syrup, which results in a hard or soft coating (applicant's claims 54-56, 61).

7. Claims 23-25, 30, 31, 37, 40, 43, 52 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. Finding the optimum amount of each component (claims 23-25, 30, 31, 37, 40, 43, 52, 64-66) would require nothing more than routine experimentation by one reasonably skilled in this art. The coating components (claims 58-60, 62) are conventional chewing gum coating components.

8. Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al in view of Li et al (6,153,231, col. 7, lines 60-61). It would have been obvious to include a pharmaceutical agent in the chewing gum of Goldberg et al

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since it is conventional to include such an active ingredient in chewing gum, as evidenced by Li et al.

9. Claims 57-60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al in view of Meyers (5,433,960, cols. 3 & 9-13 and claims 1,16, 27). It would have been obvious to coat the chewing gum in Goldberg et al with a coating as claimed by applicant in order to provide storage stability to the chewing gum since it is well known to coat chewing gum products with each of applicant's claimed coating materials in order to achieve this objective, as evidenced by Meyers.

10. Claims 1, 2, 5, 12, 18, 19, 22-29, 32-44, 46, 47, 50-53 and 63-67 are also rejected under 35 U.S.C. 102(b) or (e) as being clearly anticipated by Li et al (6,153,231, cols. 5-8 and the claims) or Li et al (6,613,363, cols. 3-8 and the claims), respectively. Both patents disclose a chewing gum, free of non-biodegradable polymers (claims 26, 27, 46), including at least two different biodegradable polymers as claimed by applicant (claims 2, 5, 12, 18, 19, 47, 50) and in the amounts claimed by applicant (claims 22-25, 64-66). The chewing gum also includes conventional ingredients as claimed by applicant (claims 28, 29, 32-44, 51, 53, 63) as well as the amounts of sweetener, filler and softener as claimed by applicant (claims 37, 40, 43, 52).

11. Claims 3, 4, 6-11, 13-17, 30, 31 and 45 are also rejected under 35 U.S.C. 103(a) as being unpatentable over either Li et al patent. Finding the optimum molecular weight and glass transition temperature (claims 3, 4, 6-11, 13-17) and the optimum amount of flavoring agent (claims 30, 31) would require nothing more than routine experimentation

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by one reasonably skilled in this art. Many of the active ingredients claimed in claim 45 are conventional chewing gum active ingredients.

12. Claims 54-62 are also rejected under 35 U.S.C. 103(a) as being unpatentable over either Li et al patent in view of Meyers. Meyers is applied as in paragraph no. 9 above.

13. Claims 1, 2, 5, 9-12, 18-53 and 63-67 are further rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grijpma et al (5,672,367, cols. 1-3). Grijpma et al discloses a chewing gum, free of non-biodegradable polymers, including at least two different biodegradable polymers as claimed by applicant (claims 2, 5, 12, 18-21, 47-50), having glass transition temperatures as claimed by applicant (claims 9-11) and in the amounts claimed by applicant (claims 22-25, 64-66). The chewing gum also includes conventional ingredients as claimed by applicant in the amounts claimed by applicant (claims 22, 28-45, 51-53).

14. Claims 3, 4, 6-8 and 13-17 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Grijpma et al. Finding the optimum molecular weight and glass transition temperature (claims 3, 4, 6-8, 13-17) would require nothing more than routine experimentation by one reasonably skilled in this art.

15. Claims 54-62 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Grijpma et al in view of Meyers. Meyers is applied as in paragraph no. 9 above.

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1-67 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over: claims 1-62 of copending Application No. 10/472,122; claims 1-54 of copending Application No. 10/472,154; claims 1-7 and 10-57 of copending Application No. 10/528,927; claims 1-64 of copending Application No. 10/528,930; claims 1-20, 22-26 and 28-42 of copending Application No. 10/529,133; claims 1-55 of copending Application No. 10/529,137 and claims 1, 2, 10, 11, 13-18, 24-26 and 28-54 of copending Application No. 11/088,109. Although the conflicting claims are not identical, they are not patentably distinct from each other because the chewing gum claimed in the claims of each of said applications is merely an obvious variation of the chewing gum claimed by applicant in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur L. Corbin whose telephone number is (571) 272-1399. The examiner can normally be reached on Monday-Friday from 10:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur L Corbin  
Primary Examiner  
Art Unit 1794

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